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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,018

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Philippe Roquiny

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EXAMINER

PATEL, VINOD D

ART UNIT

PAPER NUMBER

3742

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,018	Applicant(s) ROQUINY, PHILIPPE	
	Examiner VINOD D. PATEL	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/23/05</u> . | 6) <input type="checkbox"/> Other: _____ |

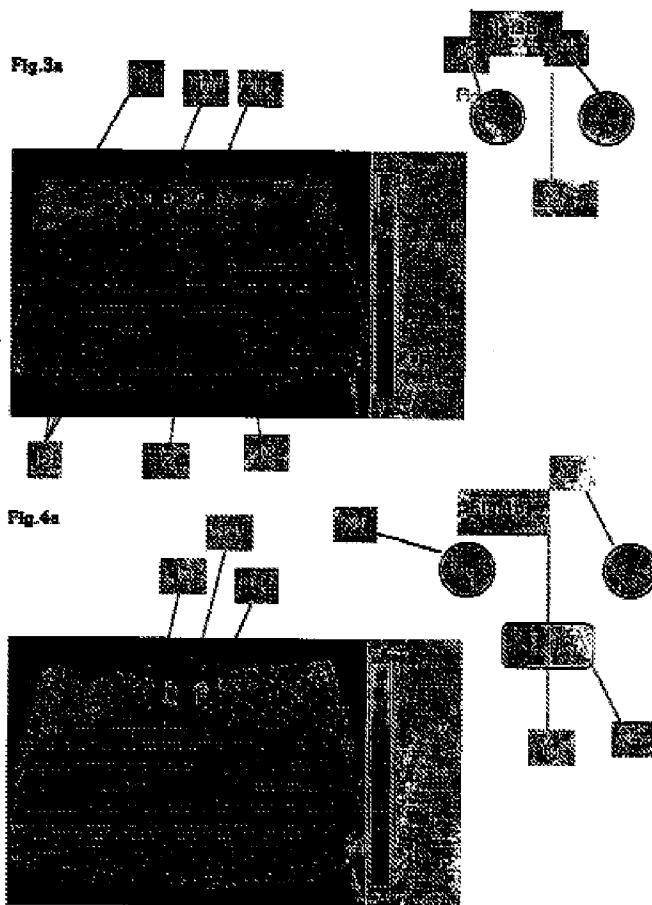
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Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because submitted drawings appears to be copy of photograph and are not visible at all. Copy of the drawings is shown below. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

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Specification

2. The disclosure is objected to because of the following informalities: Specification refers to claims, e.g., page 2, line 20 and 22, “as defined in claim 1.” Since claim(s) may change or cancelled or deleted, specification should not refer to claim(s).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2 and 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "which, when submitted to a power" in lines 8. It is unclear for what is submitted to a power. Claim 1 appears to be incomplete for omitting essential elements for submitting power, such omission amounting to a gap between the elements. See MPEP § 2172.01. Furthermore, the phrase "when submitted to a power...does not exceed 25°C" recited at lines 7-12 renders the claim indefinite because it is unclear for the state of the panel when it is noted submitted to such power or any power. Claim 1 is directed to an article "panel", therefore such phrase is merely considered as functional/operational languages which would not contribute to patentable weight to the claim as a whole. If applicant intended to recite the type or characteristics for the coating layer, such structural limitations are suggested. If applicant intended to incorporate such process of operating/performing/manufacturing into this article claim, then this were a typical hybrid claim would be rejected under 35 USC 101 statutory. In general, such phrase has made the scope of the claim uncertain.

6. Claims 24 and 25 are method claims and are indefinite for being dependent from the preceding article claim 20 or 21. Furthermore, there are insufficient antecedent basis for "the design and size" recited in claims 24 and 25 from the preceding claim. As for the same reason set forth previously, since claims 24 and 25 appeared to

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incorporate both article and method (i.e., hybrid claim), they are directed to non-statutory subject matter.

Claims 1-25 are therefore also rejected under 35 U.S.C. 101 because the claimed recitation of both article and process (i.e., hybrid), results in an improper definition of either a process or an article (i.e., at least results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-2 and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sol (US6492619) in view of Di Trapani (US5624591).

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Sol discloses a vehicle glazing panel (Figure 1-6) comprising: (i) an electrically heatable radiation-reflective coating layer (3), (ii) at least two bus bars (7, 8, 9) adapted to relay electrical power to the coating layer, and (iii) at least a window (window for rain sensor (21)) in the coating layer, permeable to electromagnetic radiations.

With respect to claim 1, Sol discloses claimed structure but does not disclose when submitted to a power of 1000 W/m² during 4 minutes, presents in a portion of the glazing panel delimited by the bus bars and not including the bus bars tips and their close periphery, a maximum temperature and a minimum temperature, characterised in that the difference between the maximum temperature of the glazing panel with the window and the maximum temperature of the same glazing panel without window does not exceed 25°C.

With respect to claim 2, Sol discloses claimed structure but does not disclose the difference between the maximum temperature of the glazing panel with the window and the maximum temperature of the same glazing panel without window does not exceed 15 °C.

With respect to claim 19, Sol discloses claimed structure but does not disclose the difference between the maximum temperature and the minimum temperature of the glazing panel does not exceed 35 °C or 20 °C.

With respect to claim 20, Sol discloses claimed structure including the window is a disk without coating layer or the window is a substantially circular zone without coating layer but does not disclose the window has a diameter comprised between 30 and 80 mm without coating layer or the window has a diameter comprised between 40 and 70

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mm without coating layer or the window having an area of between 7 and 50 cm², or the window having an area of between 12 and 40 cm² or the window is a zone wherein the coating layer is absent from a pattern of dots arranged linearly or the window is a zone wherein the coating layer is absent from a pattern of dots arranged in alternative rows or the window is a zone wherein the coating layer is absent from a pattern of dots and in which the dots without the coating layer have diameters of at least 5 mm.

With respect to claim 21, Sol discloses claimed structure including at least two windows permeable to electromagnetic radiations, in which the two windows are separated but does not disclose a distance of at least 100 mm or 150 and 500 mm. or at least three windows permeable to electromagnetic radiations, in which one window is substantially a rectangle with rounded corners wherein no coating layer is present, or at least three windows permeable to electromagnetic radiations, in which one window is substantially a rectangle with rounded corners wherein no coating layer is present, and having a size in the range of 50 to 100 mm width and 25 to 75 mm high.

With respect to claim 22, Sol discloses claimed structure including the window permeable to electromagnetic radiations is entirely surrounded by the electrically heatable radiation-reflective coating layer.

With respect to claim 23, Sol discloses claimed structure including the glazing panel is an automotive windscreen.

With respect to claim 24, Sol discloses claimed structure including a method of reducing the phenomena of hot spots in a glazing panel provided with an electrically heatable radiation-reflective coating layer and at least a window in the coating layer,

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permeable to electromagnetic radiations, by adjusting the design and size of the window.

With respect to claim 25, Sol discloses claimed structure including a method of reducing the phenomena of hot spots in a glazing panel provided with an electrically heatable radiation-reflective coating layer and at least a window in the coating layer, permeable to electromagnetic radiations, by adjusting the design and size of the window.

Di Trapani discloses a glazing panel (Figure 1-2) comprising: (i) an electrically heatable radiation-reflective coating layer (16), (ii) at least two bus bars (17) adapted to relay electrical power to the coating layer. The arrangement according to the invention allows the adjustment of the electrical voltage applied to the heated panel, starting from the local source voltage (for example 220 V for some trains) according to the electrical characteristics of the installed heated panel. Starting from a series of coated panels, this arrangement allows one to obtain for each panel a specific electrical heating output power specified by the required specification by taking account of the type of coating and the dimensions of the coating. It also permits one to optionally modify the specific heating output power of the heated panel during its installation if one finds, for example, that the heating output power set out in the specification is not correct or does not take into account the specific power requirements at the place of installation. Also, certain temporary conditions, such as a momentary increasing demand for power, can be accommodated. For a heated panel the specific power demand is generally between 400 and 1500 W/m.². A specific power of 750 W/m.² leads in general to a

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temperature of about 60 degree. C. With a power of 1000 W/m^2 , one may achieve 85 degree to 90.degree C.

It would have been obvious to provide a glazing panel submitted to a power of 1000 W/m^2 or desired power, desired shape and size of window, desired number of windows in order to heat for particular minutes at particular temperature as required in claims 1-2 and 19-25 as taught by Di Trapani in order to allows one to obtain for each panel a specific electrical heating output power specified by the required specification by taking account of the type of coating and the dimensions of the coating by adjustment of the electrical voltage applied to the heated panel, starting from the local source voltage according to the electrical characteristics of the installed heated panel for the vehicle glazing panel of Sol.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINOD D. PATEL whose telephone number is (571)272-4785. The examiner can normally be reached on 7.15 A.M. TO 3.45 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu B. Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinod D. Patel/ 10/08/08
Examiner, Art Unit 3742

/TU B HOANG/

Supervisory Patent Examiner, Art Unit 3742